

REMARKS

Claims 18-47 are pending and at issue in the instant application. In the most recent Official Action, claims 18-47 were rejected as anticipated by Hite et al. and claim 41 was additionally rejected as indefinite under 35 U.S.C. § 112, second paragraph.

As an initial matter, the applicants note that claim 41 does not include the recitation “the schedule,” as incorrectly asserted by the Examiner on page 3 of the Official Action. It appears that the Examiner may be referring to the recitation “...data elements associated with the scheduling and display...” in line eight of independent claim 41. In any event, the applicants have amended claim 41 to eliminate the word “the” immediately preceding the word “scheduling” to eliminate any potential lack of clarity in the claim. Accordingly, the applicants respectfully request that the indefiniteness rejection of claim 41 be withdrawn.

Turning to the art rejection, the applicants respectfully submit that the rejection of claims 18-47 as anticipated by Hite et al. is legally unsupportable and, thus, must be withdrawn. Specifically, the Examiner’s contention on page 2 of the most recent action that Hite et al. inherently discloses the use of advertisement objects and linked image objects, as recited by the claims at issue in this application, is asserted without a proper legal basis. “In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In this instance, the Examiner has failed to provide either a basis in fact or a line of technical reasoning that reasonably supports the contention that Hite et al. discloses advertisement objects and linked image objects. To the contrary, the Examiner’s contention

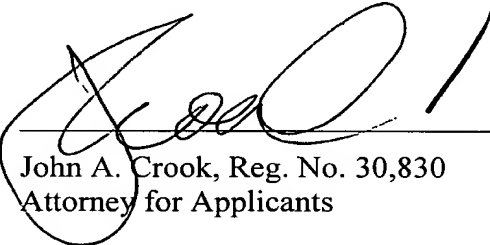
that Hite et al. discloses the use of advertisement objects and linked image objects is in conflict with the description of the operation of the system disclosed by Hite et al. Namely, the system disclosed by Hite et al. transmits video commercials in a streaming video format such as, for example, the well-known MPEG format. See col. 10, lines 1-11. The reception and display of such streaming video broadcasts does not utilize linkages between two different types of objects. Instead, as Hite et al. discloses, such streaming broadcasts may be displayed by simply tuning to a particular frequency and selecting a desired digital data stream. See col. 6, lines 28-32. Thus, it cannot be reasonably argued that advertisement objects and linked image objects necessarily flow from the teachings of Hite et al., particularly in view of the fact that such separate objects and associated linkages are completely unnecessary to the operation of the system disclosed by Hite et al. Accordingly, the Examiner's anticipation rejection based on a theory that Hite et al. inherently discloses the use of advertisement objects and linked image objects is legally unsupportable and must be withdrawn.

Conclusion

Reconsideration of the application and allowance thereof are respectfully requested. In the event that the Examiner elects to maintain the rejections based on an inherency theory under Hite et al., the applicants urge the Examiner to enter the foregoing amendment and withdraw the indefiniteness rejection to reduce the issues for appeal. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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VERSION WITH MARKINGS SHOWING CHANGES MADE

In the Claims:

41. (Amended) A system for generating digital advertisements, the system comprising:

a processor;

a computer readable medium coupled to the processor ; and software stored on the computer readable medium and adapted to be executed by the processor to:

generate a plurality of advertisement objects, each of which includes data elements associated with [the] scheduling and display of one of the digital advertisement;

generate an identifier object having data elements identifying ones of the advertisement objects for use in selecting ones of the digital advertisements for display; and

link image objects containing image information associated with the digital advertisements to the advertisement objects.
